REMARKS

This communication is a full and timely response to the non-final Office Action dated July 23, 2008. Claims 1 and 4-11 remain pending and claims 2 and 3 are cancelled. By this communication, claims 4, 7, and 8 are amended.

In numbered paragraphs 2-4 on page 2 of the Office Action, claims 4, 7, and 8, respectively stand objected to for alleged informalities. Applicant appreciates the Examiner's diligence in examining the application, and respectfully submit that these claims are amended in an effort to remedy the alleged deficiencies. Accordingly, withdrawal of these objections is respectfully requested.

Applicant's claims were variously rejected under 35 U.S.C. §103. For example, on page 3, paragraph 6 of the Office Action, claims 1, 6 and 9-11 are rejected under 35 U.S.C. §103(a) for alleged unpatentability over *Takemoto* (U.S. Patent No. 6,335,742) in view of *Johnson* (U.S. Patent Publication No. 2002/0107847); on page 5, paragraph 7 of the Office Action, claims 1,6 and 9-11 are rejected under 35 U.S.C. §103(a) for alleged unpatentability over *Takemoto* in view of *Tanaka* (U.S. Patent No. 6,345,270); on page 6, paragraph 8 of the Office Action, claim 4 is rejected under 35 U.S.C. §103(a) for alleged unpatentability over *Takemoto* in view of *Fowler* (US. Patent Publication No. 2002/0194166); on page 8, paragraph 9 of the Office Action claims 4 and 5 are rejected under 35 U.S.C. §103(a) for alleged unpatentability over *Takemoto* in view of *Kleinberger* (U.S. Patent No. 5,062,074); on page 9, paragraph 10 of the Office Action, claim 7 is rejected under 35 U.S.C. §103(a) for alleged unpatentability over *Takemoto* in view of *Petroni et al* (U.S. Patent No. 5,987,411); on page 11, paragraph 11 of the Office Action, claim 8

is rejected under 35 U.S.C. §103(a) for alleged unpatentability over *Takemoto* in view of *Doganata et al* (U.S. Patent Publication No. 2003/0220913); and on page 12, paragraph 12 of the Office Action, claim 8 is rejected under 35 U.S.C. §103(a) for alleged unpatentability over *Takemoto* in view of *Luo et al* (U.S. Patent Publication No. 2003/0195871). Applicant respectfully traverses these rejections.

As variously shown in Figures 1-5, Applicant describes a data management apparatus 20 that assigns keyword to each data file input by data input apparatus 10. When a user assigns a data file to a prescribed folder, the data management apparatus 20 selects appropriate keywords from among the keywords for the other data files that already exist in that folder, and adds them to the newly assigned data file. The CPU 201 of the data management apparatus 20 extracts all keywords from each file that already exist in the prescribed folder. The CPU 201 then assigns the extracted keywords to the newly assigned data file. The extracted keywords are then registered and associated with the file as its keywords.

Independent claim 1 broadly encompasses the aforementioned embodiments by reciting the following:

> A data management apparatus that manages data files, comprising:
> a storage unit that stores folders, existing data files and keywords assigned to each existing data file, wherein a name of the data file includes an extension showing the nature of the file;
> an input unit by which a user enters an instruction to move a new data file to a folder; and
> a processing unit that extracts the keywords assigned to the existing data files in the folder and assigns the extracted keywords to the new data file in response to the instruction,
> wherein said processing unit extracts keywords only from existing data files having the same extension as the new data file.

Independent claims 10 and 11 similarly recite features as noted above with respect to claim 1. As such, the following arguments presented with respect to claim 1 similarly apply to the latter claims.

Contrary to the PTO's assertions, *Takemoto* and *Johnson* fail to disclose or suggest every element recited in Applicant's claims.

The PTO alleges that *Takemoto* discloses every element recited in Applicant's claim 1, 10, and 11 except for a processing unit that extracts keywords from existing data files having the same extension as the new data file. Applicant agrees with the PTO's assertion, and adds that this reference also fails to disclose or suggest a processing unit that extracts keywords assigned to existing data files in a folder and assigns the extracted keywords to a new data file in response to an instruction entered by a user through an input unit.

Takemoto discloses a file management system and method for recognizing, managing and manipulating data files stored in a processor based system. A CPU 13 controls the entire apparatus and includes a management file 17 that stores a keyword table 17a. The keyword table 17a stores keywords input by the operator in association with the specific keyword characters. Keywords are assigned to an image file with an operator selects the "REGISTERED KEYWORDS" command from a pull down menu on a menu bar 100 in the browser screen. Based on this command, the keyword registration dialog box is displayed and the operator selects a bud for registering a keyword in the dialog box and inputs a keyword into the dialog box for registration.

Takemoto, however, fails to disclose or suggest extracting keywords assigned to existing data files as recited in Applicant's claims. More importantly, one of

ordinary skill would understand that given the guidance provided by *Takemoto*, keywords are assigned to an image file through a keyword registration dialog box (see column 11, lines 13 through 29.). In fact, there is no disclosure or suggestion in *Takemoto* in which keywords associated with previously stored image files are extracted from those image files and assigned to a new image file to be stored in the same library. Notably, *Takemoto* discloses that keywords that are registered to a thumbnail are first input by a user. As a result, the PTO appears to be reading a feature into this reference that is in contention with the concept for which the apparatus of *Takemoto* was designed.

The PTO alleges that *Johnson* remedies the deficiencies of *Takemoto* with respect to an extraction of keywords from data files having the same extension. However, even assuming arguendo that this interpretation is accurate, which Applicant does not acquiesce that it is, *Johnson* fails to contemplate, suggest, or articulate a technique or device in which the deficiencies of *Takemoto* can be cured. Specifically, *Johnson* fails to disclose or suggest extracting keywords assigned to existing data files in a folder and assign the extracted keywords to a new data file in response to an instruction to move a new data file to a folder as input by a user.

In summary, *Takemoto* and *Johnson* when applied individually or collectively, fail to disclosure or suggest every element recited in Applicant's claims. For at least this reason, a *prima facie* case of obviousness has not been established. Moreover, the additional secondary references such as *Tanaka, Fowler, Kleinberger, Petroni, Doganata,* and *Luo* also fail to disclose or suggest features that will be reasonably understood by one of ordinary skill to be analogous to Applicant's claims. For at

least these reasons, a prima facie case of obviousness has not been established with respect to any of Applicant's claims.

To establish *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Moreover, obviousness "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Sys. V. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). Based on the foregoing discussion, withdrawal of these rejections is respectfully requested.
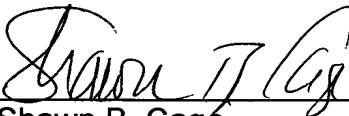
Conclusion

Based on the foregoing amendments and remarks, Applicant respectfully submits that claims 1, and 4-11 are allowable and this application is in condition for allowance. In the event any unresolved issues remain, the PTO is invited to contact Applicants representative identified below.

Respectfully submitted,

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